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EXAMINER
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CHANG, JON CARLTON

ART UNIT	PAPER NUMBER
2623	5

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/870,478

Applicant(s)

DRESEVIC ET AL.

Examiner

Jon Chang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/1/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 3, 4.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### ***Specification***

1. The specification is objected to because it fails to comply with 37 CFR 1.52(b)(6).

The paragraph numbering should consist of at least four numerals enclosed in square brackets, including leading zeros (e.g ., [0001]).

Appropriate correction is required.

2. The disclosure is objected to because of the following informalities: the U.S.

Patent Application numbers should be provided for paragraphs [01], [53] and [76].

Appropriate correction is required.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: In claim 1, at line 4,

“porting” should be changed to “portion”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 4, 6, 9 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,563,503 to Comair et al. (hereinafter "Comair").

As to claim 1, Comair discloses a computer readable medium (e.g., column 3, lines 65-66) having a data structure thereon for storing an object (column 12, line 16), said data structure comprising:

a first portion having a table, said table having blocks storing properties (column 12, lines 28, 36);

a second portion having an item, said item having an index that references one of said blocks (column 12, lines 60-61).

As to claim 3, Comair discloses the computer readable medium according to claim 1, wherein said object is a text object or a graphical object (column 12, lines 6-15).

With regard to claim 4, Comair discloses the computer readable medium according to claim 1, wherein said blocks have entries, said entries having at least one property (column 12, lines 28-42; Fig.12).

With regard to claim 6, Comair that said data structure includes plural items, wherein the number of said plural items is greater than indices in said second portion since, for example, one index references an entire table with plural entries.

As to claim 9, it is inherent that the data structure would be read. Thus, the step of reading a data structure is met by Comair. The step of determining if said data structure includes an index is implied by Compare because, for example, body

structures are linked to part components 436 within the parts table 434, which in turn are referenced by the body parts index 452 (column 12, lines 52-61). The step of associating a property block referenced by said index with an item would be inherent to the method because the index references blocks within the parts table.

As to claim 11, Comair discloses the method according to claim 9, further comprising the steps of: associating a default property with another item (column 12, lines 65-67).

As to claim 12, Comair discloses a system for creating a data structure (column 12, line 8) comprising:

- a processor (Fig.1, within element 52; Fig.16, within the workstation or console);
- and,

- a storage (Fig.1, element 56; Fig.16, within the workstation or console),
- said processor organizing an input item with a property and storing said input item with said property in a data structure in said storage (column 12, lines 36, 60-62).

Regarding claim 13, Comair discloses the system according to claim 12, wherein said data structure contains an index and a property block (column 12, lines 36, 60-62).

As to claim 14, Comair discloses a system for reading a data structure comprising:

- a storage having said data structure (Fig.1, element 56; Fig.16, within the workstation or console) said data structure including an item, a property stored in a property block and an index (column 12, lines 36 and 60-62);

a processor (Fig.1, within element 52; Fig.16, within the workstation or console);  
and

an output for outputting said item with said property (Fig.1, element 58; Fig.16, element 58'),

wherein said processor associates said item and said property through the reference to said property block by said index (column 12, line 60-62).

6. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Graphics Interchange Format, GIF89a Specification (hereinafter "the GIF Specification").

As to claim 1, the GIF specification discloses a computer readable medium (section 5, the data stream is read from a file) having a data structure (the GIF89a format is a data structure) thereon for storing an object (the object is any kind of data falling within the scope of the raster graphic data described in section 5), said data structure comprising:

a first portion having a table, said table having blocks storing properties (sections 19, 21 or 22; the various fields of the color tables are blocks, and the sub-blocks of the table based image data are blocks);

a second portion having an item, said item having an index that references one of said blocks (section 18c, "Background Color Index"; section 22a, the Table Based image data contains an index into the active color table; section 25c, "Text Foreground Color Index" or "Text Background Color Index").

As to claim 3, the GIF specification discloses the computer readable medium according to claim 1, wherein said object is a text object or a graphical object (section 5).

With regard to claim 4, the GIF specification discloses the computer readable medium according to claim 1, wherein said blocks have entries, said entries having at least one property (note, for example, in section 19c, the fields, each with a byte entry for a particular color).

With regard to claim 6, it is inherent in the GIF specification that said data structure includes plural items, wherein the number of said plural items is greater than indices in said second portion since, for example, one index references an entire table with plural entries.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 9, 11 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the GIF specification.

As to claim 9, the GIF specification does not explicitly disclose a method for reading the GIF data structure, although a number of things can be inferred from the given description. First, it is implied that the data structure would be read. Thus, the step of reading a data structure would have been obvious to one of ordinary skill in the art, based on the GIF specification. The step of determining if said data structure includes an index would have been obvious to one of ordinary skill in the art in view of the GIF specification because, for example, in section, 18c, regarding the "Background Color Index", the GIF specification states, "If the Global Color Table Flag is set to (zero), this field should be zero and should be zero and should be ignored." This implies that in the situation that the Flag is not zero, the field is not ignored (it would be read). The step of associating a property block referenced by said index with an item would be inherent to the method because the index references blocks within a color table, and the color table is inherently associated with the object being represented by the GIF.

As to claim 11, the GIF specification discloses the method according to claim 9, further comprising the steps of: associating a default property with another item (e.g.,



the Global Color Table, section 19, is used by default for an image if there is no Local Color Table).

Regarding claim 12, while the GIF specification discloses organizing an input item with a property and storing said input item with said property in a data structure (sections 19, 21 or 22) the reference does not disclose a system for creating the described data structure. However, it is clear that the data structure is intended to be created/read/utilized by computer-based systems (note for example, the specification is a "programming reference," section 4, the protocol is intended for "on-line transmission and interchange", section 5, and that the GIF data stream is "read from a file", section 5). It would therefore have been obvious to one of ordinary skill in the art to implement a computer-based system for creating the data structure. Such a computer-based system would inherently include a processor, and, a storage, and the processor would perform the function described of organizing an input item with a property and storing said input item with said property in a data structure in said storage.

As to claim 13, the GIF specification discloses the system according to claim 12, wherein said data structure contains an index and a property block (section 18c, "Background Color Index"; section 22a, the Table Based image data contains an index into the active color table; section 25c, "Text Foreground Color Index" or "Text Background Color Index").

With regard to claim 14, while the GIF specification discloses associating an item and a property through the reference to said property block by an index (section 18c, "Background Color Index"; section 22a, the Table Based image data contains an index

into the active color table; section 25c, "Text Foreground Color Index" or "Text Background Color Index"), the reference does not disclose a system for reading the described data structure. However, it is clear that the data structure is intended to be created/read/utilized by computer-based systems (note for example, the specification is a "programming reference," section 4, the protocol is intended for "on-line transmission and interchange", section 5, and that the GIF data stream is "read from a file", section 5). It would therefore have been obvious to one of ordinary skill in the art to implement a computer-based system for reading the data structure. Such a computer-based system would inherently include a storage having said data structure, a processor, and an output for outputting said item with said property, and the processor would associate said item and said property through the reference to said property block by said index.

10. Claims 2, 5, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the GIF specification and JOT - A Specification for an Ink Storage and Interchange Format (hereinafter "the JOT specification").

Regarding claim 2, the GIF specification does not disclose said object is an ink object. However, this is well known in the art as evidenced by JOT (e.g., the JOT Specification Overview section). Extending the capability of the GIF data structure to store an ink object would increase its versatility and usefulness, especially given the widespread use of electronic ink. Therefore, it would have been obvious to one of ordinary skill in the art to use the data structure described in the GIF specification to store an ink object.

As to claim 5, the GIF specification does not disclose that said item is an ink stroke. However, this is well known in the art as evidenced by JOT (e.g., see Reference Section 0.0). Extending the capability of the GIF data structure to store an ink stroke would increase its versatility and usefulness, especially given the widespread use of electronic ink. Therefore, it would have been obvious to one of ordinary skill in the art to use the data structure described in the GIF specification to store an ink stroke.

Regarding claim 7, while the GIF specification discloses associating an index with a property block (section 18c, "Background Color Index"; section 22a, the Table Based image data contains an index into the active color table; section 25c, "Text Foreground Color Index" or "Text Background Color Index"), the reference does not disclose a method for creating a data structure for storing ink. However, it is clear that the data structure is intended to be created and read (note for example, the specification is a "programming reference," section 4, the protocol is intended for "on-line transmission and interchange", section 5, and that the GIF data stream is "read from a file", section 5). It would therefore have been obvious to one of ordinary skill in the art to implement a method for creating the data structure. The GIF specification also does not disclose storing ink. However, this is well known in the art as evidenced by JOT (see JOT Specification Overview). Extending the capability of the GIF data structure to store ink would increase its versatility and usefulness, especially given the widespread use of electronic ink. Therefore, it would have been obvious to one of ordinary skill in the art to use the data structure described in the GIF specification to store ink. The combination of the GIF specification and the JOT specification would

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receive at least one stroke (note e.g. the JOT specification, Reference Section 0.0);  
creating a table of at least one property block (the GIF specification, section 19);  
associating an index with said at least one stroke, said at least one stroke including an  
index to said at least one property block (the GIF specification, section 18c,  
"Background Color Index"; section 22a, the Table Based image data contains an index  
into the active color table; section 25c, "Text Foreground Color Index" or "Text  
Background Color Index", and the JOT specification).

As to claim 10, see the remarks made above with respect to claim 5.

### ***Allowable Subject Matter***

11. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of copending Application No. 09/852799. Although the conflicting claims are not identical, they are not patentably distinct from each other because current claim 12 covers the same subject matter but with a broader recitation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***References Cited***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication 2002/0013795 A1 to Dresevie et al. discloses serial storage of ink and its properties.

"The Handwritten Trie: Indexing Electronic Ink" by Aref et al. discloses a data structure for indexing electronic ink.

"On Handling Electronic Ink" by Aref et al. discloses a technique for handling electronic ink.

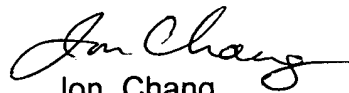
"Automatic Index Creation for Handwritten Notes" by Uchihashi et al. teaches a technique for creating an index for digital ink.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jon Chang  
Primary Examiner  
Art Unit 2623

Jon Chang  
June 28, 2004